UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,351	07/12/2000	Wlodek W. Zadrozny	728-168 (YOR9-2000-0204)	3274

			EXAMINER
28249	7590	11/03/2005	MOONEYHAM, JANICE A

DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
UNIONDALE, NY 11553

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _15 August 2005_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,4-14,16-23,46,48-56 and 82_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,4-14,16-23,46,48-56 and 82_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This is in response to the applicant's communication filed on August 15, 2005,

wherein:

Claims 1, 4-14, 16-23, 46, 48-56 and 82 are currently pending;

Claims 1, 6-7, 9, 12-14, 16, 46, 49-55, and 82 have been amended.

Claim 2 has been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claims 1, 4-14, 16-23, 46, 48-56 and 82 are rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the enablement requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention.

The applicant has amended independent claims 1, 14, 46, 52, and 82

the language "*determining by the first computing device a confidentiality level*

for the proposal for inventions," "*wherein information is provided in the forum*

according to a level of confidentiality," "*a security system structured and*

arranged for determining a confidentiality level for the proposal for invention,

for maintaining records regarding confidentiality levels and authorizing access

to secured information, the security system including at least one

microprocessor." The above subject matter has not been described in the

specification in such a way as to enable one skilled in the art to make and/or

use the invention without undue experimentation. For example, page 13 of

the specification states that *the individuals with the appropriate confidentiality*

level and co-inventor requirements are selected in step 210. Page 16 of the

specification states that *the Security System 150 keeps records regarding*

confidentiality levels and authorized access to secured information. On page

29 of the specification, applicant states that *most of these fields, except*

"Level of Confidentiality", are filled in by the initial inventor in the preferred

embodiment. On page 31 of the specification, the applicant states that *"the*

Security System 150 may have a central processing unit (CPU which uses a

heuristic analysis program to weigh these factors and determine an

appropriate confidentiality level. On the other hand, the Security System 150

may analyze the data and present a report to a patent proposal committee or

patent proposal manager, who determines the appropriate security level of

confidentiality based on their knowledge of the situation and contact with

other managers in the corporation. In short, the Security System 150

represents any type of system, computer or human which designates a

confidentiality level for a patent proposal. On page 32 the applicant states

that the *decrypted patent proposal input file 704 is sent to a Security*

Information Extractor 715, which extracts security information necessary for

the Security System 150 to determine the appropriate level of confidentiality.

This disclosed subject matter does not enable one skilled in the art to

make or use the invention without undue experimentation. Claims 4-13 are

dependent on claim 1, claims 16-23 are dependent on claim 14, claims 48-51

are dependent on claim 46, claims 53-56 are dependent on claim 52. These

claims therefore inherit the deficiencies of claims 1, 14, 46, 52, and 82.

3.   Claims 14 and 16-23 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

In claim 14, the applicant states "said Invention Proposal Server creating a

proposal for invention file from the proposal for invention." How does the server create

the proposal? Claims 16-23 depend on claim 14 and inherit the deficiencies of claim

14.

4.   Claims 49-51 and 54-55 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

The applicant has amended the claim language to read "using a

computing device structured and arranged for collecting a fee." The

Examiner respectfully request the applicant to direct the Examiner to the

specification where this is disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 14 and 16-23 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as

Mayer) in view of Takano et al (US 6434,580) (hereinafter referred to as Takano).

Regarding Claims 14,16 and 20:

Mayer discloses a system, the system comprising:

- a network of a plurality of computing devices (Figure 1 (10), page 2 [0023]);

a server for receiving information and for creating a pool (Figure 1 (12), page 3 [0037]

page 5 [0082-0083]) ;

- a computing devices for transmitting information to the server over the network. (Figure 1 (20)(30), page 2 [0023] *Figure 1 depicts a computer network 10 through which remote devices 20,30 may communicate with one or more host servers 12);* and

- a database/file for storing records (profiles) (page 3 *server 12 stores a database program which maintains one or more databases such as candidate profile database and job profile database)*

- wherein the server (12) is capable of sending a message to the pool over the network, matching criteria or qualifications and candidates; and creating (proposal/job profiles) files (Figure 4 job profiles (37), candidate profiles (36); [0037] *abstract - matching candidate information may be presented to the employer in response to a search query*; Figure 4 Profile Matching Engine; page 1 [0010] *provides an interactive employment system which allows a candidate to enter profile data and to match their criteria* [0011] *candidate can be contacted via an e-mail message or an instant message transmitted to the candidate's browser);*

- wherein the server (12) creates a file (database of stored information) (page 3 [0037] *server stores a database program and maintains one or more databases such as candidate profile database (36) and a job profile database (37). The database program stores candidate profile data, job profile data and the like).*

The language *for receiving a proposal for invention and for creating a pool of co-inventors from group of subscribers,* is intended use of the system. A recitation directed to the manner in which a claimed system is intended to be used does not distinguish the claimed system from the prior art if the prior art has the capability to so perform. In the case, Mayer is fully capable of transmitting a proposal. The databases in Mayer are fully capable of storing subscriber records with a subscriber name, contact information, etc.

Mayer does not explicitly disclose a system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information.

However, Takano discloses a security system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information (*col. 7, lines 13-26 fields for entering a piece of invention report information and file name including a reference number of draft data, an employee ID number etc; col. 8, lines 7-24 **displays on a display unit a list of all pieces of invention report information register in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department];** col. 10, lines 8-29 **only those pertaining to the inventor concerned**).*

It would have been obvious to one of ordinary skill in the art to incorporate into the

matching system of Mayer the draft data display of Takano so that only those

persons satisfying specific conditions or only data pertaining to a particular inventor

are displayed for the user.

Regarding Claim 17.

Takano discloses a system wherein the server (300) further comprises a means by

which a user can access the file and a means by which a user can add data to the file

(*col. 8, 25-32 pieces of invention report information displayed on the display unit; any*

desired piece of invention report information can be selected by entering the piece

*number; col. 10, lines 8-51 the inventor, if he or she finds it necessary to **modify** the*

revised draft data, modifies the revised draft data).

Regarding Claim 18:

Mayer discloses a system further comprising:

a web server for providing at least one web page accessible over the network, said web

page comprising a means to access and add data to a file over the network (Figure 1

(12); page 2 [0024] *server 12 maintains a web site which is hosted by the Internet. A*

candidate or employer communicates with the server through remote terminals (20, 30);

page 3 [0043] *host server 12 can direct any remote computing devices 20,30 to display*

an appropriate interface such as one or more pre-formatted web pages so that a user

can interact with the server).

Regarding Claim 19:

Mayer discloses a system further comprising a computing device for transmitting

information to a database (remote Terminals 20,30 and Network Connection (14), page

2 [0023] (Figure 1)).

Regarding Claim 21-23:

Mayer discloses a system wherein the server adds individuals to the pool by searching

a database for a candidates that match qualifications and eliminates candidates that do

not meet the qualifications (page 5 [0082][0083], *the server compares the search*

criteria to the candidate profiles stored in the database 36 and lists candidates who

match the search criteria (Figure 4 step 92) (Thus, those that do not match are

eliminated or not listed).

The confidentiality level set for the in claim record is interpreted by the Examiner to be

criteria used to make the match. Since claim 14 is directed to a system, the fact that the

record also includes a confidentiality level as a criteria is determined to be non-

functional descriptive data and cannot render non-obvious an invention that would have

otherwise been obvious. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.

Cir. 1983). The data in the record does not alter how the computer functions, i.e.

matching criteria with qualifications.

6.   Claim 52 rejected under 35 U.S.C. 103(a) as being unpatentable over www.inventors.net retrieved from the Internet Archive Wayback Machine (hereinafter referred to as InoNet) in view of Varma et al (US 6,564,246) (hereinafter referred to as Varma).

Regarding Claim 52:

InoNet discloses method of providing support for the development of inventions of a plurality of inventors over a network, the method comprising the steps of:

providing a secured forum on a network for a pool of potential co-inventors and an initial inventor to communicate and to further develop proposal for invention (page 1 *virtual network of inventors world-wide, a place of collaboration and collective magic*; page 4 *from its database InoNet chooses a group of 8-10 inventors*; page 7 *conducted in a secure electronic environment*, page 8 *InoNet selects potential team members from the InoNet database of inventive people*), the proposal being submitted by a first client/inventor (page 4 *the client company provides a full, confidential description of the problem to be solved*), wherein at one of the inventors in the pool develops a part of the invention (page 4 *from its database, InoNet chooses a group of 8-10 inventors to work on the problem*; page 5 *inventors may be able to offer patented solutions for the proplem*).

InoNet does not disclose information being displayed according to a level of confidentiality.

However, Varma discloses a shared workspace wherein information is displayed according to a level of confidentiality (col. 4, lines 8-34.*the invention supports specific access and sharing rights for each participant. For any participant, the rights can be different for each of the workspace views/interest groups available to him. Access and sharing rights of any participant can be defined/changed on an individual view or interest group basis or a multiple view or interest group basis; also,* see Figures 1 and 2; col. 1, lines 9-16 *a real-time collaboration system in which each participant can have multiple views of the shared workspace, the views of the shared workspace of different participants are not necessarily the same or homogenous, and further, the participant may have independent views of the workspace*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the shared and access and sharing rights of Varma since collaboration may require individual users to have a plurality of views of widely different characteristics and not all data is common for all of the participants.

7.   **Claims 53-56 rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet and Varma as applied to claim 52 above, and further in view of Mayer et al (2001/0034630) (hereinafter referred to as Mayer).**

Regarding Claim 53:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity, **collaboration** and collective magic;* page 1).

Neither InoNet nor Varma does not disclose the web page being stored on the server

However, Mayer discloses a web page stored on a server (page 2 [0023] and [0024], page 3 [0043-0045]).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Mayer with the collaboration disclosure of InoNet and Varma since the server cooperates to maintain the network system and perform the steps of the method and enables a candidate or an employer to interact with the server with one or more pre-formatted web pages.

Regarding Claim 54:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. Neither InoNet nor Varma disclose obtaining fees by a fee collection system.

However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the collaboration disclosure of InoNet and Varma so as to generate revenue to run the job-placement web site business.

Regarding Claim 55:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

InfoNet nor Varma disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment of fees by the employer as taught by Mayer with the

collaboration disclosure of InoNet and Varma so as to generate revenue on the basis of

the number of qualified candidates that employers actually find through the use of the

web site rather than charging for all candidates that match a particular job description so

more employers will continue to use a job placement web site since the amount of

money they are charged is proportional to the number of suitable and desirable

candidates that the employer finds through the web site.

Regarding Claim 56:

InoNet discloses the secured forum is on the Internet (InoNet retrieved from the Internet

Archive Wayback Machine)

8.   Claims 1, 4-6, 8-13, 46, and 48-51 are rejected under 35 U.S.C. 103(a) as

being unpatentable over InoNet in view of Mayer et al (US 2001/0034630)

(hereinafter referred to as Mayer) and further in view of Varma et al (US 6,564,246)

(hereinafter referred to as Varma).

Regarding Claims 1 and 46:

Inonet discloses a method for supporting the development of inventions (InoNet offers

an on-line problem-solving service for inventors and people working with intellectual

property), the method comprising the steps of:

- creating, by a computing device, a subscriber list (page 1 *users register with*

  InoNet (subscriber) and are included in *a databank of inventive people*)

comprising records having at least a name, contact information (see pages 9-13

registration information includes name and contact information), and

qualifications (pages 12-13 *Special Expertise and Education*);

- storing said list in a database (page 1, InoNet is a databank of inventive people,

   page 4 from its database, InoNet chooses a group of 8 to 10 inventors) ;

- receiving, by the computing device a proposal (page 4 *technology, product,*

   process or packaging problems are submitted)

- The Merriam Webster online dictionary retrieved from Onelook.com defines a

   proposal as:

> Main Entry: **pro·pos·al** ◀))
> Pronunciation: pr&-'pO-z&l
> Function: *noun*
> 1 : an act of putting forward or stating something for
> consideration
> 2 a : something proposed : SUGGESTION b : OFFER;
> *specifically* : an offer of marriage

- The Examiner interprets submitting a problem needing a solution as an act of

   putting forward or stating something for consideration, i.e., a proposal)

- creating, by the computing device a pool of co-inventors (page 4 *InoNet chooses*

   a group of 8-10 inventors from its database) by searching for records in the list

   (*databank of inventive people*) with qualifications matching the desired co-

   inventor qualifications (see page 7 *the database of inventive people is scanned*

and a diverse team of highly qualified people are assembled, page 8 *the*

potential team members are selected by InoNet in cooperation with the client

company), wherein said co-inventors in the created pool develop the invention

described in the proposal (see page 3 - *problems (proposal) find solutions*

(invention)).

- providing a forum for the pool of inventors to communicate and develop the

  proposal for the invention (page 1, *this is a place for creativity,* **collaboration** *and*

  collective magic; page 4 and page 7 -*the problem solving sessions takes place in*

  a secure online environment)

InfoNet does not disclose a step of contacting, by the computing device, the

subscribers in the pool or the step of submitting the desired qualifications or storing the

desired qualifications in a database.

However, Mayer discloses

- a step of contacting by the computing device the subscribers (candidates) in the

  pool (page 1 [0011] *the candidate can be contacted via an e-mail message, an*

  instant message transmitted to the candidate's browser, and the like; also see

  page 4 [0047] and [0077])

- the step of submitting the desired qualifications (page 5 [0080] and [0081]

  employer may then conduct a search for possible candidates for a job position

  by entering search criteria (qualifications)) and creating (submitting) a set of

qualifications (page 3 [0037] *server stores a database program which maintains*

one or more databases, such as a job profile database 37), page 5 [0080] *a*

process by which an employer may submit job profile data);

- the step of storing the desired qualifications in a database (page 3 [0037] *server*

  12 preferably stores a database program which maintains one or more

  databases, such as candidate profile database 36 and job profile database 37)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the submission of candidate profile information and the step of contacting

candidates as taught by Mayer with the disclosure of InoNet since the Internet is being

used to match job candidates and employers with increasing frequency and the system

allows an employer to search profile data corresponding to a plurality of candidates and

return results corresponding to candidates who match the search criteria with increased

efficiency and speed, as opposed to a manual search, and to quickly notify the

candidates without the candidates having to wait for a letter or fax.

Neither InoNet nor Mayer disclose determining a confidentiality/access level for the

proposal or wherein information is provided in the forum according to a level of

confidentiality/acess.

However, However, Varma discloses a shared workspace wherein information is

displayed according to a level of confidentiality/access (col. 4, lines 8-34 *the invention*

supports specific access and sharing rights for each participant. For any participant, the rights can be different for each of the workspace views/interest groups available to him. Access and sharing rights of any participant can be defined/changed on an individual view or interest group basis or a multiple view or interest group basis; also, see Figures 1 and 2; col. 1, lines 9-16 *a real-time collaboration system in which each participant can have multiple views of the shared workspace, the views of the shared workspace of different participants are not necessarily the same or homogenous, and further, the participant may have independent views of the workspace).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the shared and access and sharing rights of Varma since collaboration may require individual users to have a plurality of views of widely different characteristics and not all data is common for all of the participants.

Regarding Claim 48:

InoNet discloses a method further comprising providing, by the computing device, a forum for the pool to communicate and to further develop the proposal (page 1, *this is a place for creativity, **collaboration** and collective magic;* page 4 and page 7 *-the problem solving sessions takes place in a secure online environment)*

Regarding Claim 4.

InoNet discloses a method wherein the proposal is transmitted over the network (page

1 InoNet, *The Innovator's Electronic Network*, page 7 *the problem solving sessions*

takes place in a secure online environment).

Regarding Claim 5.

InoNet does not disclose a method wherein the step of creating a pool is performed by a

server.

However, Mayer discloses wherein the step of creating a pool is performed by a server

(Figure 1 (12); page 5 [0082, 0083] *the server compares the entered search criteria to*

the candidate profiles stored in the candidate profile database 36. The server next lists

candidates who match the entered search criteria (Fig. 4 (92))*.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the teaching of the server performing the function of creating the pool as

taught by Mayer with the disclosure of InoNet since the Internet is being used to match

job candidates and employers with increasing frequency and the server cooperates to

maintain the system and perform the method with increased efficiency and speed.

Regarding Claim 6:

InoNet does not disclose method wherein the step of contacting subscribers is

performed over the network.

However, Mayer discloses contacting subscribers (*candidates*) over the network (page 1 [0011] *candidate can be contacted by an email message, an instant message transmitted to the candidate's browser, an the like*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the contact teachings of Mayer with the disclosure of InoNet since an email or instant message would allow the candidates or subscribers to be notified of the match quicker and more efficiently than would be a notification sent by regular mail as a letter, or delivered by fax or phone.

Regarding Claim 8:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity, collaboration and collective magic;* page 1).

InoNet does not disclose the web page being stored on the server

However, Mayer discloses a web page stored on a server (page 2 [0023] and [0024], page 3 [0043-0045]).

It would be obvious to one of ordinary skill in the art at the time of the invention to

combine the teaching of Mayer with the disclosure of InoNet since the server

cooperates to maintain the network system and perform the steps of the method and

enables a candidate or an employer to interact with the server with one or more pre-

formatted web pages.

Regarding Claim 9:

InoNet discloses a method wherein the step of creating a subscriber list further

comprises a step of:

contacting, by an individual using a computing device, a subscriber database (page 1,

join our databank of inventive people, Register Now (hyperlink));

creating a subscriber record for the individual on the subscriber database (pages 1 and

9-13, *once registered the subscriber joins the databank of inventive people*);

inputting, by the individual, information including a name of the individual, contact

information of the individual, and qualifications of the individual into the subscriber

record (page 9-13 *name, area of interest, company affiliation, academic affiliation,*

special expertise, working style, education); and

storing the subscriber record on the subscriber database (page 1 *databank of inventive*

people, page 7 *database of specialist*).

Regarding Claim 10:

InoNet does not discloses a method wherein the step of creating a subscriber list

comprises establishing non-subscriber criteria; using said non-subscriber criteria to

select individuals, creating non-subscriber records for said selected individuals, each of

said non-subscriber records including information about a selected individual; and

maintaining said non-subscriber records on a non-subscriber database.

However, Mayer discloses a method wherein the step of creating a subscriber list

comprises establishing criteria (page 5 [0080, 0081] *employer submits job profile data*

and search criteria at web site hosted by server 12); using the criteria to select

individuals candidates (page 5 [0082] *the server then compares the entered search*

criteria to the candidate profiles stored in candidate profile database), creating records

for said selected individuals including information about a selected individual (*candidate*

profile Figure 4); and maintaining the records in a database (page 3 [0037] *candidate*

profile database (36)).

Mayer does not disclose that the candidates are non-subscribers. However, the type of

candidates is determined to be non-functional descriptive data. Nonfunctional

descriptive data cannot render non-obvious an invention that would have otherwise

been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

1983). The steps of creating the list by matching criteria would be performed the same

regardless of the type candidate.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the

teachings of Mayer with the disclosure of InoNet since the Internet is being used to

match job candidates and employers with increasing frequency and the system allows

an employer to search profile data corresponding to a plurality of candidates, thus

expanding the search, and return results corresponding to candidates who match the

search criteria with increased efficiency and speed, as opposed to a manual search.

Regarding Claim 11:

Mayer discloses adding individuals (*candidates*) to the created pool of co-inventors by

searching said database for candidates that match desired qualifications (Page 5 [0080-

0083]).

Regarding Claims 12 and 13:

Both InoNet and Mayer disclose a databank of inventive people (InoNet page 1) and

candidate profile database (Mayer Fig. 2B (36)). Mayer and Inonet further disclose

information such as contact information, employment type, education, and background

data (InoNet pages 9-13, Mayer pages 3-4 [0047-0054] and page 5 [[0065-0074])

Neither InoNet or Mayer disclose a record including a confidentiality/access level or a method wherein the confidentially level is used to eliminate a subscriber.

However, the confidentiality level would be a qualification or criteria by which the match is performed. Thus, it is determined to be non-functional descriptive data. Nonfunctional descriptive data cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Since the confidentiality level is a qualification or criteria by which the match is performed, the steps of matching the criteria with the qualifications would be performed the same regardless of what type information was entered as a qualification or criteria.

Therefore, it would be obvious to incorporate into the teaching and disclosure of InoNet and Mayer a field on the registration page or pre-formatted web page which allowed confidentiality information to be entered since intellectual property is an asset that is protected by companies and inventors and a company would not want to risk losing the potential asset to a competing company by allowing access to the information to someone who is not trustworthy, thus this person would be eliminated by the system since his/her confidentiality level would not match the criteria/qualifications necessary to make the list of potential candidates or inventors.

Regarding Claim 49:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. InoNet does not disclose obtaining fees by a fee collection system.

However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the disclosure of InoNet so as to generate revenue to run the job-placement web site business.

Regarding Claim 50:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

InfoNet does not disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and

contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the payment of fees by the employer as taught by Mayer with the disclosure

of InoNet so as to generate revenue on the basis of the number of qualified candidates

that employers actually find through the use of the web site rather than charging for all

candidates that match a particular job description so more employers will continue to

use a job placement web site since the amount of money they are charged is

proportional to the number of suitable and desirable candidates that the employer finds

through the web site.

Regarding Claim 51:

InoNet discloses a method further comprising the step of :

using a subscriber criteria (page 8 *InoNet, in cooperation with the client company*

selects potential team members) supplied by the corporation (page 6 *corporate R&D,*

page 7 *Who uses the service? Medium to large corporations*) and creating a pool of co-

inventors (page 8 *after scanning a database of inventive people, a diverse team is*

assembled, page 4 *from its database, InoNet chooses a group of 8 to 10 inventors*).

InoNet does not disclose obtaining a fee.

However, Mayer discloses a fee being paid (page 5 [0084] *employer pay a fee to unlock identification and contact data*) and *a web site host capable of charging further fees* (page 3 [0042]).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine obtaining fees as taught by Mayer with InoNet since Mayer states there is a need for an interactive employment system and method which generates revenue on the bases of the number of qualified candidates that employers find through the use of a job-placement website.

9.   **Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) in view of InoNet and further in view of Varma.**

Regarding Claim 82:

Mayer discloses computer system, the computer system comprising:

at least one computer-readable memory including (Figure 2A (25), page 3 [0034-0037] *the memory 25 may be an internal or external large capacity device for storing computer processing instruction, computer-readable data, and the like, server 12 includes a processor 31 and a memory 35 which may store one or more operating system and application programs*):

- code for maintaining a database structure of a list with records including a name, contact information, and qualifications (page 3 [0037] *server 12 stores a*

database program which maintains one or more databases, such as candidate profile database and job profile database),

- code for searching for records in the list with qualifications matching a set of desired qualifications for the invention proposal (page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists candidates who match entered search criteria)* ,

- code for creating a pool from the records that match a set of desired qualifications ((page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists (pools) candidates who match entered search criteria)* ,

Mayer does not disclose:

- code that maintains forum being accessible to the pool

- code for receiving a proposal for an invention.

However, InoNet discloses:

- code that maintains forum being accessible to the pool (page 4, *from the database of inventive people, InoNet chooses a group of 8-10 inventors (pool), page 1, this is a place for creativity, collaboration and collective magic, page 4 and page 7 – the problem solving sessions take place in a secure online environment (forum))*

- code for receiving a proposal for an invention (page 4 – *technology, product process or packaging problems (proposal is the problem needing a solution) are submitted).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the collaborative and problem solving teachings of InoNet with the disclosure of Mayer since companies can no longer depend only upon in-house resources for answers to problems, they need a place where problems find solutions and innovators find a community of like-minded people to collaborate to solve complex problems, assemble a diverse team of highly qualified people for several disciplines and industries and tap into creative resources of inventors all over the world .

Neither InoNet nor Mayer disclose code for determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/acess.

However, However, Varma discloses a shared workspace wherein information is displayed according to a level of confidentiality/access (col. 4, lines 8-34 *the invention supports specific access and sharing rights for each participant. For any participant, the rights can be different for each of the workspace views/interest groups available to him. Access and sharing rights of any participant can be defined/changed on an individual view or interest group basis or a multiple view or interest group basis; also,* see Figures 1 and 2; col. 1, lines 9-16 *a real-time collaboration system in which each participant can have multiple views of the shared workspace, the views of the shared workspace of*

different participants are not necessarily the same or homogenous, and further, the

participant may have independent views of the workspace).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the problem solving service discloses in InoNet with the shared and access

and sharing rights of Varma since collaboration may require individual users to have a

plurality of views of widely different characteristics and not all data is common for all of

the participants.

10.   **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

InoNet, Mayer, and Varma as applied to claim 1 and InoNet and further in view of

Eisenhart (2001/0047276) (hereinafter referred to as Eisenhart).

Regarding Claims 7 and 53:

Inonet does not explicitly disclose a server or each of the computing devices accessible

by one or more subscribers in the pool.

However, Eisenhart discloses a method wherein the step of providing the forum

(technology exchange and collaboration) is performed over the network by a server

(Figure 2 (242) contributor server, page 3 [0035] (contributor is one contributing to the

commercial development of the technology page 1 [0006]), each of said plurality of

computing devices being accessible by one or more subscribers in the pool of co-

inventors (contributors) (page 4 [0042])

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the server as taught in Eisenhart with the disclosure of InoNet so as to allow

the contributor to use his/her computer and the connection between the server and the

Internet to register with and access the technology exchange system.

Response to Arguments

Applicant's arguments filed on August 15, 2005 have been fully considered but

they are not persuasive.

Applicant request proof of the actual publication and the publication dates of

InoNet. First, the Examiner submits the fact that the document was retrieved from the

Internet Archive Wayback Machine is proof of publication. As for proof of date the

publication was available, the Examiner directs the applicant to page 2, top left hand

corner wherein the copyright information states that the page was revised on 24

October 1998. Pages 3, 5, 8 and 17 of InoNet state that the pages were revised on 29

April 1999. Thus, the pages existed one year prior to the applicant's priority date.

As for applicant's statement that disclosure for "the Invention Proposal server

sending a message" is found on page 55 of the specification, lines 12-16, the Examiner

notes that the specification submitted only has 49 pages.

Furthermore, the Examiner does not find disclosure for a fee collection system on

page 12, line 12, as applicant states. Line 30 states that in *an Internet embodiment,*

people could subscribe to one or all services by paying a fee. There is no

disclosure for a fee collection system or that the fees are paid using the Internet.

Moreover, the Examiner makes note of the applicant's admission that it is well known in the art that when paying fees using the Internet, a fee collection system would have to be used.

As for applicant's argument as to claim 14, these are all directed to the amended claim 14. Therefore, applicant is directed to the discussion above as to these new limitations.

As for the applicant's arguments as to confidentiality levels, the Examiner has provided a new reference in the rejections above. Applicant is directed to the discussions in the rejections.

As for the objections as to InoNet, the Examiner has addressed this in the discussion above.

The applicant argues that a proposal and a "problem needing a solution" are not the same. The Examiner expressly addressed this in the rejection above.

Applicant argues that the Examiner rejected claim 52 as being anticipated by Collective Magic. Claim 52 was rejected as being anticipated by InoNet.

As for the applicant's arguments as to any newly added limitations, the Examiner has addressed these limitations in this rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
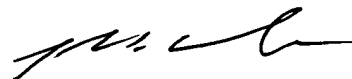
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600